

REMARKS

Applicant has carefully studied the Office Action of October 17, 2005 and offers the following remarks in response to accompany the above amendments.

Initially, Applicant amends the specification in numerous places to make the spelling of “adaptor” consistent. In particular, it appears that several instances of “terminal adaptor zone 24” were spelled “terminal adapter zone 24”. Applicant herein amends the specification so that the spelling of adaptor is consistently “adaptor” and not “adapter”. No new matter is added.

Claims 1-5, 8-17, and 21-35 were rejected under 35 U.S.C. § 103 as being unpatentable over Abidi et al. (hereinafter “Abidi”) in view of Schellinger et al. (hereinafter “Schellinger”). Applicant respectfully traverses. To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested within the combination of references. MPEP § 2143.03. If the Patent Office cannot establish obviousness, the claims are allowable.

Claim 1 recites “using a temporary directory number.” A temporary directory number is contrasted from a primary directory number of the PSTN in paragraph 0005 of the specification as filed. The Patent Office admits that this element is not taught by Abidi (see Office Action of October 17, 2005, page 3, lines 5-10). The Patent Office relies on Schellinger to supply the missing element. However, a close examination of Schellinger reveals that Schellinger also fails to teach the recited claim element. Specifically, the Patent Office asserts that Schellinger, col. 8, lines 29-34 and col. 8, lines 44-48 teach the temporary directory number. The Patent Office explains “the cellular leg of the 3 way call is the temporary directory number. . .” (Office Action of October 17, 2005, page 3, lines 17-18). Applicant traverses this assertion.

Schellinger, col. 8, lines 29-34 states in full:

. . . block 725. At block 725, the PCC 101 operating in a cordless telephone system requests that the cordless base station 115 perform a handoff from the cordless to cellular telephone system 103 by producing a three way call between the PCC 101, the other party and the user's cellular phone number.

The passage does indicate that there is a three way call, but indicates that the user's cellular phone number is used in the three way call. Earlier, Schellinger specifies that the cellular phone number is a normal directory number (see Schellinger, col. 6, lines 10-30) and is not, under any reasonable interpretation, a temporary directory number. Thus, this passage and its three way

call does not indicate that the combination teaches a temporary directory number as recited in the claims.

Schellinger, col. 8, lines 44-48 states in full:

. . . remains in the call in the cordless telephone system. In FIG. 7-2 the PCC 101 answers the cellular leg of the three way call at block 727 to open communication between the PCC 101 operating in the cellular telephone system 103 and the other party. Thus, the PCC 101. . . .

Again, while the passage does indicate that there is a three way call, and that there is a cellular leg, the earlier passage confirms that the user's cellular number is used to make the cellular leg. Since the cellular number is not a temporary number, the three way call does not teach the temporary number recited in the claims.

In short, the references individually do not teach or suggest the temporary directory number recited in claim 1. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the Patent Office has not established obviousness.

Claim 22 recites, in relevant part, the same element. The Patent Office relies on the same passages of Schellinger for its rejection. As explained above, the combination of Abidi and Schellinger does not teach or suggest the temporary directory number, and the Patent Office has not established obviousness for claim 22.

Claims 2-5, 8-17, and 21 depend from claim 1 and are not obvious for at least the same reasons. Claims 23-35 depend from claim 22 and also are not obvious for at least the same reasons. Applicant requests withdrawal of the § 103 rejection of claims 1-5, 8-17, and 21-35 at this time.

Applicant notes that claim 40 is also addressed in this section, although it is not formally rejected by the Patent Office. To the extent that claim 40 depends from claim 22, claim 40 is patentable for at least the same reasons.

Claim 6 was rejected under 35 U.S.C. § 103 as being unpatentable over Abidi and Schellinger in further view of Thyssen. Applicant respectfully traverses. For the Patent Office to combine references in an obviousness determination, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent

Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. Specifically, the Patent Office asserts the motivation to combine Thyssen is "to provide a method of transmitting data over the internet and bypass the charges associated with a typical phone call." (Office Action of October 17, 2005, page 8, lines 17-19). This asserted motivation lacks the evidence required by the Federal Circuit. Since the motivation lacks the required evidence, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper, and the Patent Office has not established obviousness. Applicant requests withdrawal of the § 103 rejection on this basis.

Applicant further traverses the rejection because the combination does not show the temporary directory number as recited in independent claim 1. As explained above, Abidi and Schellinger do not teach or suggest this element. The Patent Office points to nothing in Thyssen that cures the deficiencies of the first two references. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness, and claim 6 is allowable. Applicant requests withdrawal of the § 103 rejection of claim 6 on this basis as well.

Claims 7, 20, and 38 were rejected under 35 U.S.C. § 103 as being unpatentable over Abidi in view of Schellinger and in further view of Bell. Applicant respectfully traverses. The standards for establishing obviousness are set forth above.

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. Specifically, the Patent Office asserts that the motivation to combine the references is "to provide wireless communications to a user" or "to provide a low cost method of short range wireless voice and data links between devices." (Office Action of October 17, 2005, page 9, lines 8-9 and lines 19-20, respectively). These asserted motivations lack the evidence required by the Federal Circuit. Since the motivations lack the required evidence, the motivations are improper. Since the motivations are improper, the combination is improper. Since the combination is improper, the rejection is improper, and

the Patent Office has not established obviousness. Applicant requests withdrawal of the § 103 rejection on this basis.

Applicant further traverses the rejection because the combination does not show the temporary directory number as recited in independent claims 1 and 22. As explained above, Abidi and Schellinger do not teach or suggest this element. The Patent Office points to nothing in Bell that cures the deficiencies of the first two references. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness, and claims 7, 20, and 38 are allowable. Applicant requests withdrawal of the § 103 rejection of the claims on this basis as well.

Claims 18, 19, 36, and 37 were rejected under 35 U.S.C. § 103 as being unpatentable over Abidi and Schellinger in further view of Charney et al. (hereinafter "Charney"). Applicant respectfully traverses. The standards for establishing obviousness are set forth above.

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. Specifically, the Patent Office asserts the motivation is "to provide a method of supporting simultaneous communications via a plurality of communication channels within the cordless telephone system." (Office Action of October 17, 2005, page 10, lines 14-16). This asserted motivation lacks the evidence required by the Federal Circuit. Since the motivation lacks the required evidence, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper, and the Patent Office has not established obviousness. Applicant requests withdrawal of the § 103 rejection on this basis.

Applicant further traverses the rejection because the combination does not show the temporary directory number as recited in independent claims 1 and 22. As explained above, Abidi and Schellinger do not teach or suggest this element. The Patent Office points to nothing in Charney that cures the deficiencies of the first two references. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness, and claims are allowable. Applicant requests withdrawal of the § 103 rejection of claims 18, 19, 36, and 37 on this basis as well.

Claim 39 was rejected under 35 U.S.C. § 103 as being unpatentable over Abidi and Schellinger in further view of Bartle et al. (hereinafter "Bartle"). Applicant respectfully traverses. The standards for establishing obviousness are set forth above.

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. Specifically, the Patent Office asserts the motivation is "to provide a method of notifying the user of an imminent communication mode change in a dual mode cellular telephone." (Office Action of October 17, 2005, page 11, lines 13-15). This asserted motivation lacks the evidence required by the Federal Circuit. Since the motivation lacks the required evidence, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper, and the Patent Office has not established obviousness. Applicant requests withdrawal of the § 103 rejection on this basis.

Applicant further traverses the rejection because the combination does not show the temporary directory number recited in independent claim 1. As explained above, Abidi and Schellinger do not teach or suggest this element. The Patent Office points to nothing in Bartle that cures the deficiencies of the first two references. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness, and claim 39 is allowable. Applicant requests withdrawal of the § 103 rejection of claim 39 on this basis as well.

Applicant requests reconsideration of the rejections in light of the amendments and remarks provided herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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